

121 AF/3625

PTO/SB/21 (04-04)

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/378,678	
	Filing Date	August 20, 1999	
	First Named Inventor	McCarthy, Mary K.	
	Art Unit	3625	
	Examiner Name	Pond, Robert M.	
Total Number of Pages in This Submission	11	Attorney Docket Number	022275-000500US

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to Technology Center (TC)
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Terminal Disclaimer	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Request for Refund	Return Postcard via USPS only
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Certified Copy of Priority Document(s)	Remarks	The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.
<input type="checkbox"/> Response to Missing Parts/Incomplete Application		
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

RECEIVED

JUL 26 2004

GROUP 3600

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Townsend and Townsend and Crew LLP Jonathan E. Jobe Reg. No. 28,429
Signature	
Date	July 15, 2004

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 and faxed to 703-746-7206 on the date shown below.			
Typed or printed name	Julie C. Freiburger		
Signature		Date	July 15, 2004

*** TX REPORT ***



TRANSMISSION OK

TX/RX NO	1292
RECIPIENT ADDRESS	17037467206
DESTINATION ID	
ST. TIME	07/15 15:47
TIME USE	03'31
PAGES SENT	12
RESULT	OK

RECEIVED

JUL 26 2004

GROUP 3600

Atty Docket No. 022275-000500US

PTO FAX NO.: 703-746-7206

ATTENTION: Examiner Robert M. Pond

Group Art Unit 3625

OFFICIAL COMMUNICATION**FOR THE PERSONAL ATTENTION OF****EXAMINER ROBERT M. POND****CERTIFICATION OF FACSIMILE TRANSMISSION**

I hereby certify that the following document(s) in re Application of McCarthy et al., Application No. 09/378,678, filed August 20, 1999 for METHOD OF AND SYSTEM FOR DELIVERING COMBINED SOCIAL EXPRESSION GIFT CARDS AND GIFT CERTIFICATES is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Document(s) Attached

1. Transmittal
2. Supplemental Appeal Brief

Number of pages being transmitted, including this page: 12



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: McCarthy, Mary K. et al.
Serial No: 09/378,678
Filed: August 20, 1999
Title: METHOD OF AND SYSTEM
FOR DELIVERING COMBINED
SOCIAL EXPRESSION CARDS
AND GIFT CERTIFICATES

) Examiner: Pond, Robert M.
)

) Art Unit: 3625
)

) Certificate of Mailing
)

) I hereby certify that this paper is being deposited
with the United States Postal Service as first
class mail on July 15, 2004, is addressed to the
Mail Stop Appeal Brief-Patents, Commissioner
for Patents, P.O. Box 1450, Alexandria, VA
22313-1450, and is being faxed to 703-746-
7206.
)

) By: _____
)

SUPPLEMENTAL APPEAL BRIEF

RECEIVED

JUL 26 2004

GROUP 3600

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Applicant has appealed from the Examiner's final rejection of claims 6-32. The Applicant filed its Appeal Brief. This Supplemental Appeal Brief corrects a typographical error in claim 19 in the Appendix. This Supplemental Appeal Brief also corrects the Status of Claims.

1. Real Party in Interest:

The real party in interest in this Appeal is Hallmark Cards Incorporated.

2. Related Appeals and Interferences:

There are no related appeals or interferences.

3. Status of Claims:

Claims 6-32 are pending. Claims 1-5 and 33-35 have been canceled. The claims on appeal are claims 6-32, which are set out in the Appendix.

4. Status of Amendments:

There were no amendments after final rejection.

5. Summary of the Invention:

The present invention provides a method of and system for producing combined social expression cards and gift certificates for delivery to recipients. According to the present invention, the term gift certificate includes all items or indicia that may be exchanged for goods or services, including, but not limited to in store certificates, coupons, stored value cards, and the like.

As illustrated in Figure 1 and describe in the specification at page 7, line 19, through page 9, line 14, the present invention is preferably implemented in a Web-based client-server environment in which remotely located customers use standard Web browsers running on customer PCs 13 to access a Web server 15. The Web server presents a remotely located customer with a selection of social expression card designs and a selection of gift certificates. In response to customer selection of a card design and a gift certificate, the system of the present invention delivers a combined social expression card and gift certificate to a recipient designated by the customer. Delivery according to the present invention may be accomplished either by printing and mailing a physical product to the recipient or by delivering an electronic version to the recipient. The selection, fulfillment and delivery processes according to the present invention are illustrated in the flow diagram of Figures 2 and 3 and described in the specification at page 9, line 15, through page 12, line 19.

The user interface of the present invention is illustrated in Figures 4-14 and described in the specification at page 12, line 20, through page 17, line 11. The present invention enables a customer to select a gift certificate by displaying to the customer a list of merchants from which gift certificates are available. The merchants may be national, regional, or local. In order to enable a customer to select a merchant located near the recipient, the customer may access a list of locations for a selected merchant. Preferably, the system of the present invention displays a list of states in which the selected merchant has at least one location. In response to customer selection of state from the list of states, the system displays a list of locations for the selected merchant within the selected state.

After the customer has selected a social expression card style and a merchant for the gift certificate, the system of the present invention prompts the customer to designate the number of recipients to whom the selected combined card is to be sent and the amount of the gift. The customer may thus designate one or more recipients of a particular card. The customer may

enter a gift amount or select an amount from a list of predefined amounts. The system of the present invention prompts the customer to personalize each card with the recipient's and sender's name and a sentiment, which may be selected from a list of predefined sentiments or entered by the customer.

After the customer has completed selection of a gift card or a set of gift cards, the customer may add the card or set of cards to a "shopping basket." When the customer is finished shopping, the customer may check out by authorizing the operator of the system to charge the contents of the shopping basket to a credit card or some established customer. Upon receipt of credit card verification, the system provides the customer with a confirmation number and proceeds to production and fulfillment of the order.

In the embodiment in which a physical card is mailed to the recipient, the data selected by the customer is converted into a file with fields that can be recognized by a digital printing press. The converted file is transmitted to a print server at a printing location. The print server may store files until a certain number of transactions have been processed, at which time the stored files may be released to a digital press for batch printing.

The combined social expression card and gift certificate may be produced by printing on both sides of a single sheet of material. The recipient's name and mailing address and the sender's name and return address are printed on one side of the sheet. The personalized sentiment is printed on the other side of the sheet. The gift certificate is printed on a separable portion of the sheet. Preferably the sheet of material is folded around the separable portion with the side bearing the names and addresses exposed and sealed to form a self mailer, although alternative mailing arrangements are within the scope of the present invention. The gift cards may be individually stamped and mailed, or they may be boxed for bulk transport to the customer or other party for mailing. An example of a combined social expression card and gift certificate according to the present invention is illustrated in Figures 15-19.

6. Issues:

Whether claims 6-7, 10, 11, 16-20, 25-27 and 29-32 are unpatentable under 35 U.S.C. §103 over Small U.S. Patent No. 5,513,117, in view of a collection of papers referred to as Borders.com.

Whether claims 8, 9 and 12-15 are unpatentable under 35 U.S.C. §103 over Small in view of Borders.com as applied to claim 30 further in view of a paper referred to as PR Newswire.

7. Grouping of Claims:

Claims 6, 7 and 16-32 stand or fall together.

Claims 8-15 stand or fall together.

8. Argument:

Section 103 -- Small in view of Borders.com

The sole independent claim is claim 30. Claims 6-7, 10, 11, 16-20, 25-27 and 29-32 are rejected under 35 U.S.C. §103 as being unpatentable over Small in view of Borders.com. Small discloses a computer implemented system that allows a customer to design and personalize a greeting card and deliver an electronically vendable gift on or with the greeting card. Small discloses presenting a user with a selection of card designs and a list of merchants from whom gift certificates are available. However, Small does not disclose displaying a list of locations for a merchant in response to selection of a merchant from the list of merchants. Borders.com discloses a store locator page that can be reached from the Borders.com homepage. After a user has arrived at the Borders.com store locator page, the user can determine if there is a Borders store near a specified location.

The fact that Small may disclose certain elements of the claimed invention and Borders.com may disclose other elements of the claimed invention does not satisfy the Examiner's duty to make a *prima facie* case of obviousness. In order to make a *prima facie* case of obviousness, there must be a teaching, suggestion or motivation to make the claimed combination either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. It should be noted, however, that the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 1161 (Fed. Cir. 1999). The Examiner has not pointed to any teaching or suggestion or motivation in either reference to make the asserted combination. Accordingly, the Examiner has failed to make a *prima facie* case of obviousness with respect to claim 30.

Moreover, the Applicant submits that even combining the Small and Borders.com references does not yield the claimed invention. In claim 30, a list of locations is displayed in response to selection of a merchant from a list of merchants. Neither Small nor Borders.com discloses that step. Neither Small nor Borders.com teaches launching a store locator from a list of merchants. The store locator feature of Borders.com is launched not from a list of merchants but from a page of the Borders.com Website. Although Small discloses a list of merchants, there is no suggestion in Small of launching a store locator from the list of merchants. Accordingly, the combination of Small and Borders.com does not result in the invention as claimed in claim 30.

Since all of the claims depend from claim 30, the Applicant respectfully submits that all of the claims are allowable.

Section 103 -- Small in view of Borders.com and PR Newswire

Claims 8, 9 and 12-15 are rejected under 35 U.S.C. §103 as being unpatentable over Small in view of Borders.com as applied to claim 30 further in view of a paper referred to as PR Newswire. Since claims 10 and 11 depend from claim 8, the Applicant believes the Examiner intended to reject those claims as unpatentable over Small in view of Borders.com and PR Newswire, rather than over Small in view of Borders.com as indicated in the final office action.

PR Newswire is an article that announces and describes an online shopping service provided by the fashion specialty retailer Nordstrom, Inc. PR Newswire devotes a single sentence to a description of a multiple shipping feature of the Nordstrom online shopping service. That single sentence reads as follows:

"Other built-in conveniences include a multiple shipping feature that allows customers to ship their purchases to different addresses across the country in single order."

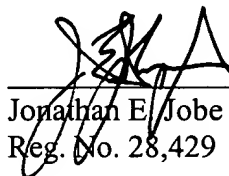
That single sentence does not suggest the invention as claimed in any of claims 8-15. Claim 8, from which claims 9-15 depend, includes the step of prompting the user to designate a number of combined social expression cards and gift certificates to be delivered from a selected merchant. The prompting step is performed in response to selection of a merchant from the list of merchants. The step claim 8 is not disclosed or suggested in PR Newswire. PR Newswire is silent as to how the multiple shipment feature is invoked. Since the multiple shipment feature is part of the Nordstrom online shopping service it certainly cannot be invoked by selecting a

merchant from a list of merchants. Moreover, there is no disclosure or suggestion in PR Newswire that a user is prompted to enter a number of items to be delivered from a selected merchant. The Applicant submits that the Examiner's rejection is based on speculation about how the Nordstrom system works guided by the Applicant's claims and disclosure. The Applicant submits that the Examiner's rejection of claim 8 is erroneous. Claims 9-15 are directed to steps of the present invention that are performed depending on the number of items entered at the prompt of claim 8. Those steps are clearly not disclosed in PR Newswire. Accordingly, the Applicant submits that claims 8-15 are allowable.

Conclusion

The Applicant has demonstrated that the Examiner's rejections are erroneous. Accordingly, the Examiner's rejections should be reversed.

Respectfully submitted,



Jonathan E. Jobe
Reg. No. 28,429

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 858-350-6100
Fax: 415-576-0300

APPENDIX

6. The method as claimed in claim 30, including the step of, in response user selection of a merchant from said list of merchants, prompting said remotely located user to designate a gift certificate amount.

7. The method as claimed in claim 6, wherein said step of prompting said user to designate a gift certificate amount includes the step of presenting to said user a list of available gift certificate amounts.

8. The method as claimed in claim 30, including the step of, in response to user selection of a merchant from said list of merchants, prompting said remotely located user to designate a number of combined social expression card and gift certificates from said selected merchant to be delivered.

9. The method as claimed in claim 8, wherein said step of prompting said remotely located user to designate a number of combined social expression card and gift certificate to be delivered includes the step of prompting said user to enter a number of combined social expression card and gift certificates from said selected merchant to be delivered.

10. The method as claimed in claim 8, including the step of, if said designated number is equal to one, prompting said user to identify a recipient of said combined social expression card and gift certificate.

11. The method as claimed in claim 10, wherein said step of prompting said user to identify said recipient includes the step of prompting said user to enter a name and address for said recipient.

12. The method as claimed in claim 8, including the step of, if said designated number is greater than one, prompting said user to identify said designated number recipients greater than one.

13. The method as claimed in claim 12, wherein said step of prompting said user to identify said designate number of recipients greater than one includes the step of presenting to said user a list of combined social expression card and gift certificates, the number of combined social expression card and gift certificates in said list being equal to said designated number of recipients greater than one.

14. The method as claimed in claim 13, including the step of, in response to user selection of a combined social expression card and gift certificate from said list, prompting said user to identify a recipient of said combined social expression card and gift certificate selected from said list.

15. The method as claimed in claim 14, wherein said step of prompting said user to identify said recipient includes the step of prompting said user to enter a name and address for said recipient.

16. The method as claimed in claim 30, including the step of prompting said user to personalize said combined social expression card and gift certificate.

17. The method as claimed in claim 16, wherein said step of prompting said user to personalize said combined social expression card and gift certificate includes the step of presenting to said user a list of sentiments.

18. The method as claimed in claim 16, wherein said step of prompting said user to personalize said combined social expression card and gift certificate includes the step of prompting said user to enter a sentiment.

19. The method as claimed in claim 30, including the step of printing said combined social expression card and gift certificate at a central location.

20. The method as claimed in claim 19, wherein said step of delivering said combined social expression card and gift certificate includes the step of mailing said combined social expression card and gift certificate from said central location to said addressee.

21. The method as claimed in claim 19, wherein said step of printing said combined social expression card and gift certificate includes the step of printing said combined social expression card and gift certificate on both sides of a single sheet of material.

22. The method as claimed in claim 21, wherein said step of printing said combined social expression card and gift certificate on both sides of a single sheet of material includes the steps of:

printing a recipient name and mailing address on a first side of said sheet; and,
printing a sender name and return address on said first side of said sheet.

23. The method as claimed in claim 21, wherein said step of printing said combined social expression card and gift certificate on both sides of a single sheet of material includes the step of:
printing a personalized sentiment on a second side of said sheet.

24. The method as claimed in claim 22, including the step of folding said printed sheet into a mailer with said first side exposed.

25. The method as claimed in claim 24, wherein said sheet of material includes a separable portion and said step of step of printing said combined social expression card and gift certificate includes the steps of printing said gift certificate on said separable portion.

26. The method as claimed in claim 25, including the step of folding said separable portion over said second side of said sheet of material prior to folding said sheet of material into said mailer.

27. The method as claimed in claim 30, wherein said step of delivering said combined social expression card and gift certificate includes the step of delivering an electronic version of said

combined social expression card and gift certificate to an electronic mail address for said addressee.

28. The method as claimed in claim 30, wherein said gift certificate includes a coupon.

29. The method as claimed in claim 30, wherein said gift certificate includes a stored value card.

30. A method of providing combined social expression cards and gift certificates, which comprises the computer implemented steps of:

- presenting a remotely located user with a selection of social expression card designs;
- displaying to said remotely located user a list of merchants from which gift certificates are available;

- in response to user selection of a merchant from said list of merchants, displaying a list of locations for said selected merchant;

- presenting said remotely located user with a selection gift certificates available from said selected merchant;

- in response to user selection of a card design and a gift certificate, delivering a combined social expression card and gift certificate to an addressee designated by said remotely located user.

31. The method as claimed in claim 30, wherein said step of displaying a list of locations includes the step of displaying a list of states in which said selected merchant has at least one location.

32. The method as claimed in claim 31, wherein said step of displaying a list of locations includes the step of, in response to user selection of state from said list of states, displaying a list of locations for said selected merchant within said selected state.